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OFFICE OF PETITIONS

In re Application of
F. Read McFeely et al. :
Application No. 09/378,502 :
Filed: August 20, 1999 :
Attorney Docket No: YO999-198 :

ON PETITION

This is a decision on the petition filed December 27, 2004, for reconsideration of an adverse decision, on a petition to withdraw the holding of abandonment under 37 CFR 1.181, or in the alternative, to revive the above identified application under 37 CFR 1.137(a)¹.

The petition to withdraw the holding of abandonment is **GRANTED**.
The petition to revive under 37 CFR 1.137(a) is **DISMISSED** as involving moot issues.

The application was held abandoned on September 14, 2002, for failure to file a timely response to the Notice to File Corrected Application Papers mailed August 13, 2002, requiring a new oath or declaration with the first inventor's mailing information. The notice set a (30) day shortened period for reply and the time for reply was not extendable under 37 CFR 1.136(a) or (b). Accordingly, a Notice of Abandonment was mailed on February 4, 2003.

In a petition to withdraw the holding of abandonment under 37 CFR 1.181, filed October 19, 2004, petitioner asserted that a response to the Notice to File Corrected Application Papers had been timely filed and submitted a copy of the reply said to have been mailed to but not received in the U.S. Patent and Trademark Office. The document contains a certificate of mailing dated September 13, 2002, and is signed by petitioner's counsel, Thomas A. Beck. Petitioners have also provided a copy of a postcard receipt itemizing the filing of a declaration and identifying the application by serial number, attorney docket

¹A grantable petition under 37 CFR 1.137(a) must be accompanied by:

- (1) the required reply, unless previously filed; In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In a nonprovisional utility or plant application filed on or after June 8, 1995, and abandoned for failure to prosecute, the required reply may also be met by the filing of a request for continued examination in compliance with § 1.114. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.
- (2) the petition fee as set forth in 37 CFR 1.17(l);
- (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and
- (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c).

number, and inventor's last name, bearing an Office-date stamp of September 23, 2002.²

However, the petition to withdraw the holding of abandonment was dismissed because it was not filed within (2) two months of the mailing of the Notice of Abandonment on February 4, 2003.

With the instant request for reconsideration, petitioner asserts that proof of a timely response to the Notice of Abandonment was also undertaken. Petitioner shows again by post card receipt bearing a USPTO postmark, that on March 19, 2003, a declaration and receipt for filing were filed in the instant application, to show that a response had been properly and timely filed to the Notice to File Corrected Application Papers. Unfortunately that response was also not associated with the file.

Although the response purportedly filed March 19, 2003 was not filed in the format of a petition, it and the evidence presented in the petition filed October 19, 2004, substantially complies with the requirements set forth in 37 CFR 1.8(b) and 37 CFR 1.181 and MPEP 503. The totality of the evidence presented points to a conclusion that the substance is there if not the form.

Accordingly, the holding of abandonment is withdrawn. In view thereof, the petition under 37 CFR 1.137(a) is moot. The petition fee is unnecessary and therefore will not be charged to petitioner's deposit account.

It is noted also that the petition to withdraw the holding of abandonment included at Exhibit "5", a copy of the Issue Fee Transmittal (PTOL-85B) also said to have been timely filed on July 29, 2002. The Issue Fee Transmittal has with it a certificate of mail dated July 29, 2002 and authorizes the payment of the issue fee from deposit account no. 05-0510.

This matter is being referred to the Publishing Division.

Telephone inquiries concerning this matter may be directed to the undersigned Petitions Attorney at (571) 272-3212.


Patricia Faison-Ball
Senior Petitions Attorney
Office of Petitions

²The USPTO has a well-established and well-publicized practice of providing a receipt for papers filed in the USPTO to any applicant desiring a receipt. The practice requires that any paper for which a receipt is desired be filed in the USPTO with a self-addressed postcard identifying the paper. A postcard receipt which itemizes and properly identifies the papers which are being filed serves as prima facie evidence of receipt in the USPTO of all the items listed thereon on the date stamped thereon by the USPTO. See section 503, Manual of Patent Examining Procedure (MPEP 503).